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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,002	08/16/2005	Richard Wade	2859-1-001PCT/US	9394
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KLAUBER & JACKSON 411 HACKENSACK AVENUE HACKENSACK, NJ 07601			EXAMINER MAZUMDAR, SONYA	
			ART UNIT	PAPER NUMBER
			1791	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/520,002

**Applicant(s)**

WADE, RICHARD

**Examiner**

SONYA MAZUMDAR

**Art Unit**

1791

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 5-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's amendments, see page 4 in remarks filed February 19, 2009, with respect to rejection of claims 11 and 14 under 35 USC 112, 1<sup>st</sup> paragraph, have been fully considered, and the rejection has been withdrawn.
2. Applicant's amendments and arguments, with respect to claims 1, 2, 5, 6, and 8-12 have been considered, but are not fully persuasive.

Boreali teaches multiple catch points (12) may be provided around each label (10), depending on the shape and configuration, so all catch points will not be broken until the label is fully removed from the web (column 3, lines 53-61). The labels are connected to the matrix (17) by ties, so the ties are broken as the labels are separated from the matrix material, automatically (column 4, lines 64-67). Applicant also argues that Boreali teaches additional stages, however applicant's claim uses "comprising" which allows the use of additional stages.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, although Boreali teaches placing labels onto a conveyor belt, conveyor bottom rollers, conveying slats,

conveying chains, toothed wheels, or a wide variety of other mechanisms as the conveying means, as the labels are separated from the matrix (column 4, lines 7-11), it is acknowledged that there is no specific teaching of placing the labels directly onto the surface of a product container. Bekker-Madsen teaches a method of applying adhesive labels (8) to products (13) directly after separating the labels from a backing material (9) (column 2, lines 53-65; column 3, lines 7-14; Figure 1). Applicant argues that Bekker-Madsen teaches severing the label before application, however, Bekker-Madsen is not used for this teaching, but to indicate that it is known in the art to directly apply the labels to a product instead of a web.

Furthermore, Boreali teaches that conventional bursters typically operate at a differential speed ratio preferably between 3:1 and 2:1, including all ratios in between. There is a motor (28) provided with a matrix take-up roller (27) to help control the detachment of the labels from the matrix (Figure 5). Also, a sensor 38 (of any suitable conventional type, e.g., optical) is preferably provided to sense a leading label after it has been burst, and to in turn move a surface into contact with the label and a second sensor may also be provided to sense a moving surface to which the detached label is to be applied (column 5, lines 16-26).

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 2, and 5-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 1 recites the limitation "the said protruding leading edge" in line 14. There is insufficient antecedent basis for this limitation in the claim.
6. Claim 1 recites the limitation "the beak" in line 21. There is insufficient antecedent basis for this limitation in the claim; also, the beak is already referred to as the guide (32).
7. Claim 1 recites the limitation "the same" in line 22. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 2, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boreali (US 5,573,621) in view of Bekker-Madsen (US 5,112,427).

Boreali teaches a method of separating linerless, adhesive labels on a single layer label matrix web (17), where labels (11), with an adhesive surface (14) and an opposing release surface (13), are disposed at spaced intervals. The label boundaries are defined in the web by lines of cutting passing through the web, leaving the defined label connected to the remainder of the web by catch points (12). To remove the labels,

the web is fed around a guide member (22), without damaging the label and such that the adhesive surface of the label does not face the guide. The leading edge of each label protrudes out of the plane of the web and this protruding edge forms a means whereby the remainder of the label can be extracted from the web by breaking the catch points (column 3, column 4, lines 12-24; Figures 4 and 5). On a side note, multiple catch points may be provided around each label, depending on the configuration, so all catch points will not be broken until the label is fully removed from the web (column 3, lines 53-61).

Boreali teaches placing labels onto a conveyor belt, conveyor bottom rollers, conveying slats, conveying chains, toothed wheels, or a wide variety of other mechanisms as the conveying means (column 4, lines 7-11). However, there is no specific teaching of placing the labels directly onto the surface of a product container. Bekker-Madsen teaches a method of applying adhesive labels (8) to products (13) directly after separating the labels from a backing material (9) (column 2, lines 53-65; column 3, lines 7-14; Figure 1).

Furthermore, claim 1 discloses using an applicator of "the same function and operation as the conventional beak of conventional application machinery" (lines 5 and 6). Thus, it would have been obvious to have the adhesive surfaces of the labels on a single web contact and adhere to the product, to avoid extra costs of a separate backing material (Bekker-Madsen: column 1, lines 30-53; Figure 1).

With respect to claim 2, Boreali in view of Bekker-Madsen teach leading edges of labels to be sufficiently devoid of holding points to ensure that it will reliably protrude

from a matrix web (17) when it passes around the guide (22) (Boreali: Figure 5; Bekker-Madsen: column 1, line 57 – column 2, line 3).

With respect to claim 6, Boreali in view of Bekker-Madsen teaches labels with a first surface, opposite the adhesive surface, to act as a release material (Boreali: column 3, lines 44-51).

With respect to claim 8, Boreali in view of Bekker-Madsen teaches applying labels which are self-adhesive (Boreali: abstract; Bekker-Madsen: column 3, lines 7-14).

10. Claims 5, 10, 11, and 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Boreali in view of Bekker-Madsen as applied to claims 1 and 2 above, and further in view of Jeffries (US 3,880,692).

The teachings of claims 1 and 2 are as described above.

Although Boreali in view of Bekker-Madsen teach labels to have an adhesive surface (Boreali: abstract), there is no specific teaching of applying adhesive to labels on a single-layer web. However, Jeffries teach applying adhesive to a single layer-web of labels, in which the labels are further detached from the web (column 6, lines 6-52; Figures 5, 6, and 7). Thus, it would have been obvious to apply adhesive to labels before being detached from a web to prevent adhesive accumulation in the apparatus (abstract).

11. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boreali in view of Bekker-Madsen, as applied to claim 2 above, and further in view of West et al. (US 5,275,678)

The teachings of claim 2 are as described above.

Boreali in view of Bekker-Madsen does not teach a water application station to wet adhesive on a label prior to application product containers. However, West et al. teach applying water via a water application means (17) to labels (15) with adhesive glue strips (20) prior to applying the labels onto containers (18) (column 5, lines 66 – column 6, line 5; Figures 1 and 2). It would have been obvious to apply water onto an adhesive portion of the label as West et al. taught and would have been motivated to do so to prevent adhesive accumulation in an apparatus and residue on a container's surface (column 4, lines 51-60).

12. Claims 7, 13, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bekker-Madsen in view Osaka (US 6,030,482).

Bekker-Madsen teach self-adhesive labels (8) on a single web (2) to be applied to products (13), where the labels are spaced out on the web and the labels are defined in a web by punching sections (44, 45, 46, 47) are bridges (73, 74, 75, and 76) (column 4, lines 44-53; Figures 8 through 13).

Bekker-Madsen does not teach providing labels with silicon applied to a first surface of a label to act as a release material. However, Osaka teaches it would have been obvious to one having ordinary skill in the art to apply a silicone release agent (18) over a printed layer (20) on a label, in a case where the label web is rolled up and surfaces do not stick to each other (column 2, lines 33-38; column 10, lines 43-47; Figure 1b).

If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or

intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999).

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **SONYA MAZUMDAR** whose telephone number is (571)272-6019. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Tucker can be reached on (571) 272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SM

/Philip C Tucker/  
Supervisory Patent Examiner, Art Unit 1791